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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 7

Application Number: 09/718870
Filing Date: November 20, 2000
Appellant(s): ENGSTROM, ERIC
ORT, JEFFREY G.

Eric Engstrom
Jeffrey Ort
For Appellants

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04/01/04.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

The appeal involves claims 1-24.

Claims 1-24 were rejected under U.S.C. 102(b), and 103(a).

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is substantially correct, except for the last 4 lines of the Summary where the Appellant states "the user may concurrently run some less sensitive applications.....when the surrounding environment is sufficiently "private". This privacy characteristic of the invention is not presented in the original disclosure. The use of "visible" plane for running "publicly" "less sensitive applications" and "invisible" plane for running "privately" "more sensitive applications", described in the Summary in the brief as a novel feature of the application, is not found in the original disclosure.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-24 stand or fall together:

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,880,733	Horvitz et al	03-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 3-6, 11, 13-16 and 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by Horvitz et al (hereinafter "Horvitz ", USP 5,880,733).

Claims 2, 7-10, 12, and 17-20 were rejected under U.S.C. 103(a) as being unpatentable over Horvitz.

The detailed rejections are as follows:

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless :

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3-6, 11, 13-16 and 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Horvitz et al (USP 5,880,733).

Regarding claims 1, 11 and 21, Horvitz teaches displaying execution results of a first plurality of applications in a first plane (front plane) of a metaphoric desktop (see the front plane 38 in Fig, 3) and Horvitz teaches displaying execution results of a second plurality of applications in a second plane (back plane) of the metaphoric desktop (see the back plane 44 in Fig, 3) (also see lines 45-59 of col. 10).

Regarding claims 3, 13 and 22, Horvitz teaches the transition (morphing) from the first plan to the second plane as the front plane is transformed (morphed) to the back plane in response to detection of a predetermined event (event of selecting push back button 64) (see col. 12, lines 31-50, also see figure 13, col. 19, lines 32-61).

Regarding claims 4, 14 and 23, Horvitz further teaches that planes can be rotated 90, 180, 270 or 360 degrees over the vertical axis as illustrated in figure 13.

Regarding claims 5, 15 and 24, Horvitz further teaches that plurality of the planes (plurality of portion of metaphoric desktop) can be rotated 90, 180, 270 or 360 degrees over the vertical axis as illustrated in figure 13.

Regarding claims 6 and 16, Horvitz further teaches first and second planes are front plane (38 in figure 3) and back plane (44 in figure 3).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 2, 7-10, 12, and 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horvitz et al (USP 5,880,733).

Regarding claims 2 and 12, Horvitz differs from the claim in that Horvitz does not explicitly specify that one of the running applications is an on-line application or web-related application. In figure 3, Horvitz shows windows applications on desktop. However, it is old and well known in the art that web-browser is a windows applications. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a web-browser as a windows applications in Horvitz's desktop with the motivation being to enable world wide web access for Horvitz's desktop.

Regarding claims 7 and 17, Horvitz differs from the claim in that Horvitz does not explicitly specify that the display of the execution result of the second applications comprises redirecting the graphics service to store pictorial representations of the results of the first application to an alternate display buffer and to store pictorial representations of the results of the second application to the current display buffer. However, it is old and well known in the art that the current display buffer is used to

store pictorial representations of the results of the application that is currently being selected for display. Thus, if the second application is selected for display, then the current display buffer has to store pictorial representations of the results of the second application and redirect the results of the first application to an alternate display buffer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to redirect the results of the first application to an alternate display buffer and to store pictorial representations of the results of the second application in the current display buffer with the motivation being to enable the system to properly display the result of the second application and not the first application.

Regarding claims 8 and 18, Horvitz differs from the claim in that Horvitz does not explicitly specify that one of the running applications is an on-line application or web-related application. In figure 3, Horvitz shows windows applications on desktop. However, it is old and well known in the art that web-browser is a windows applications. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a web-browser as the second windows applications in Horvitz's desktop with the motivation being to enable world wide web access for Horvitz's desktop.

Regarding claims 9-10 and 19-20, when the user select the first application again for display, the system of Horvitz would then resume storing the pictorial representations of the results of the first application in the current or standard display buffer.

(11) Response to Argument

In response to Appellant's argument that "Horvitz failed to teach each and every limitation of claims 1, 11, and 21", it is noted that such is not quite the case since Horvitz teaches displaying execution results of a first plurality of applications in a first plane (front plane) of a metaphoric desktop (see the front plane 38 in Fig, 3) and Horvitz teaches displaying execution results of a second plurality of applications in a second plane (back plane) of the metaphoric desktop (see the back plane 44 in Fig, 3) (also see lines 45-59 of col. 10).

In response to Appellant's argument that "Horvitz clearly considers his 3D-logical WORKSPACE" to be different and distinct from a 2-D metaphoric desktop", it is noted that this argument is only Appellant's allegation and has no basis. Nowhere in the reference shows Horvitz teaches that his invention is different and distinct from a 2-D metaphoric desktop. On the contrary, the 3-D workspace seen in Fig, 3 is in fact a virtual 3-D workspace (see col.3, lines 1-3) generated on a 2-D display screen 15 (see Fig. 3, also see col. 3, lines 56-63). In other words, the 3-D workspace seen in Fig. 3 is simulated to provide a sense of depth for 2-D display screen (abstract). Therefore, Horvitz's 3-D workspace is of a 2-D metaphoric desktop. As also seen in Fig. 3, the front plane 38 and back plane 44 are of the 2-D screen 15, i.e. 2-D metaphoric desktop.

In response Appellant's argument that "the "front" plane which is normally visible, and the "back" plane which is visible only if the planes are flipped", it is noted that this argument is not persuasive since these features are not presented in the claims. A careful review of the claims affirms that the claims are totally silent regarding whether a

plane is visible or on which condition a plane is visible. Therefore, this argument is not supported since it bases on unclaimed features.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (visible characteristics of a plane) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Appellant's argument regarding "the "privacy" claim 1 can offer for the computing scenario described in the Summary of Invention section", it is noted that "the privacy capability" that the Appellant relies on in the argument are not presented anywhere in the application, not in the claims, not even in the specification. Please note that claim 1, as well as the other two independent claims 11 and 21, cites "displaying first execution results of a first plurality of applications in a first plane of a metaphoric desktop; and displaying second execution results of a second plurality of applications in a second plane of the metaphoric desktop". Not a word in these claims discloses, or even remotely mentions, the "privacy function" which the Appellant relies on as a "novel teaching" of the present application. This argument is totally unsupported since Appellant argues the claims based on a "privacy" function which is not found in either the claims or specification.

For the above reason, it is believed that the rejections should be sustained.

Respectfully submitted,

Kieu D. Vu
05/14/04

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